Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JONATHAN RICHARD CLARE,
CARL-ERIC KAISER and VIRGINIA PANKRATZ

Appeal No. 2003-1850
Application 09/783,510

ON BRIEF

Before GARRIS, WARREN and POTEATE, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 20, all of the claims in the application. Claim 1 is illustrative of the claims on appeal:

1. An automatic dishwashing detergent composition comprising, by weight:

(a) from about 0.01% to about 5% of a blooming perfume composition comprising from about 50% to about 99% of blooming perfume ingredients having a boiling point less than about 260°C and a ClogP of at least about 3, said perfume composition comprising at least 5 different blooming perfume ingredients, and from about 0.5% to about 10% of base masking perfume ingredients having a boiling point of more than about 260°C and a ClogP of at least about 3;

(b) an effective amount of a bleaching agent or detergent enzyme;

(c) from about 10% to about 75% of a detergent builder; and

(d) automatic dishwashing detergent adjunct material selected from the group consisting of detergent surfactant, bleach adjunct material, pH-adjusting material, chelating agent, dispersant polymer, material care agent, suds suppressor, and mixtures thereof.

The appealed claims, as represented by claim 1, are drawn to an automatic dishwashing detergent composition comprising at least the specified blooming perfume composition which comprises at least from about 0.01% to about 5% of at least five different blooming perfume ingredients and at least from about 0.5% to about 10% of base masking perfume ingredients, wherein both the blooming perfume ingredients and the base masking perfume ingredients must have a ClogP of at least about 3, but the former has a boiling point of less than about 260°C while the latter has a boiling point of more than about 260°C. The ClogP is the perfume ingredient's octanol/water partition coefficient (P) that is the ratio between its equilibrium concentrations in octanol and in water, stated in the form of their logarithm to the base 10, logP, wherein "C" is the temperature, which is disclosed in the specification to be 25°C (specification, page 4). According to appellants, the blooming perfume composition mask odors from bleaching agents and/or detergent enzymes (specification, page 1).

The reference relied on by the examiner is:

Trinh et al. (Trinh) WO 97/34987 Sep. 25, 1997
(published World Intell. Prop. Org. Application)

The examiner has rejected appealed claims 1 through 20 under 35 U.S.C. § 103(a) as being unpatentable over Trinh.[1]

Appellants group the appealed claims as claims 1 through 4, 6, 7 12 through 17 and 19; claim 5; claims 8 through 11; claim 18; and claim 20 (brief, page 5). Thus, we decide this appeal based on appealed claims 1, 5, 8, 18 and 20. 37 CFR § 1.192(c)(7) (2002).

We affirm.

Rather than reiterate the respective positions advanced by the examiner and appellants, we refer to the examiner's answer and to appellants' brief and reply brief for a complete exposition thereof.

[1] The examiner has withdrawn the ground of rejection under 35 U.S.C. § 102(b) (answer, page 2).

Opinion

We have carefully reviewed the record on this appeal and based thereon find ourselves in agreement with the supported position advanced by the examiner (answer, pages 3-4) that, *prima facie*, one of ordinary skill in this art following the teachings of Trinh would have employed base masking perfume ingredients in the amount specified in the appealed claims, and would have used water to form a liquid or gel composition in the amount specified in the appealed claims, in the reasonable expectation of arriving at an automatic dishwashing detergent composition. We add the following to the examiner's analysis.

We find that the generic description of the automatic dishwashing detergent compositions disclosed in Trinh (e.g., page 4) contains essentially the same amount of a blooming perfume composition comprising blooming perfume ingredients as recited in appealed claim 1, the sole difference being that there is no indication in the broad recitation of the amount of base masking perfume ingredients which can be present. Trinh discloses that the amount of non-blooming perfume ingredients which have a boiling point of more than 260C° "should be minimized" in the disclosed compositions (page 10, lines 4-6). We find in Trinh Table 3 "non-limiting examples of non-blooming perfume ingredients" which includes by stated boiling point and approximate ClogP values, base masking perfume ingredients that satisfy the limitation of "a boiling point of more than about 260°C and a ClogP of at least about 3" in the appealed claims. Indeed, as the examiner points out, the listing in Trinh Table 3 includes a number of base masking perfume ingredients listed in specification Table 4 (answer, page 3). We find that forty four (44) of the fifty two (52) "non-blooming perfume ingredients" listed in Trinh Table 3 satisfy the claim limitation for base masking perfume ingredients. As appellants point out, there are a number of base masking perfume ingredients in each of perfume compositions A through D of Trinh, the total amounts of such ingredients ranging from 16% to 24% (brief, page 9). The examiner finds that the sole non-blooming perfume ingredient of perfume composition F of Trinh is present in the amount of 5% and recognizes that this ingredient does not satisfy the claim limitation with respect to base masking perfume ingredients (answer, pages 5).

It seems to us from this substantial evidence that, *prima facie*, one of ordinary skill in this art would have reasonably selected one or more of the non-blooming perfume ingredients from

Trinh Table 3 and used the same in desired amounts in the automatic dishwashing detergent compositions disclosed in the reference in the reasonable expectation of obtaining a composition having the properties taught in the reference. *See generally*, *Merck & Co., Inc. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1845-46 (Fed. Cir. 1989) ("That the '813 patent discloses a multitude of effective combinations does not render any particular formulation less obvious. This is especially true because the claimed composition is used for the identical purpose."); *In re Susi*, 440 F.2d 442, 445, 169 USPQ 423, 425 (CCPA 1971) ("As appellant points out, Lauerer's disclosure is huge, but it undeniably includes at least some of the compounds recited in appellant's generic claims and is of a class of chemicals to be used for the same purpose as appellant's additives."); *In re Lemin*, 332 F.2d 839, 841, 141 USPQ 814, 815-16 (CCPA 1964)("Generally speaking there is nothing unobvious in choosing 'some' among 'many' indiscriminately."). Because the reference provides guidance with respect to the amount of base masking perfume ingredients as "minimal," and even though the perfume compositions exemplify amounts ranging from 16% to 24 % for base masking perfume ingredients, we determine that one of ordinary skill in this art working within the reference would have arrived at a workable or optimum range for such amounts to suite his or her desires, and would not have been limited in this respect by the amounts in the examples. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) ("[W]here general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation."); *see also Merck v. Biocraft*, 874 F.2d at 807, 10 USPQ2d at 1846, quoting *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976) ("But in a section 103 inquiry, 'the fact that a specific [embodiment] is taught to be preferred is not controlling, since all disclosures of the prior art, including unpreferred embodiments, must be considered.'"). Our determination here includes appealed claims 1, 5 and 8.

With respect to the amount of water which can be present in the claimed compositions of appealed claims 18 and 20, the examiner finds that the written description of automatic dishwashing detergents in the specification includes "liquids" at page 1, line 13 (answer, page 4). We find that the reference further teaches that adjunct materials, which are included in the claimed compositions as well, "are selected based on the form of the composition, i.e., whether

the composition is to be sold as a liquid . . . " (specification, page 31, lines 7-8). The Trinh Examples include an amount of water or moisture consistent with the form in which the product will be sold, with several requiring an amount of water or moisture greater than 20%. Thus, we agree with the examiner that, *prima facie*, one of ordinary skill in this art would have selected the amount of water to be used in the compositions of Trinh based on the form of the composition desired, and thus would have arrived at a workable or optimum range for such amounts that fit the desired form of the composition. *Aller*, *supra*.

Accordingly, based on the substantial evidence in Trinh, we determine that, *prima facie*, one of ordinary skill in this art routinely working within the teachings of the reference would have reasonably arrived at compositions falling within the appealed claims without recourse to appellants' specification.

Therefore, since a *prima facie* case of obviousness has been established over Trinh, we have again evaluated all of the evidence of obviousness and nonobviousness based on the record as a whole, giving due consideration to the weight of appellants' arguments in the brief and reply brief. *See generally, In re Johnson*, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

We have considered appellants' arguments in the brief (pages 12-17) and reply brief with respect to the ground of rejection under 35 U.S.C. § 103. With respect to appealed claim 1, appellants contend that there is insufficient guidance or incentive to select any of the non-blooming perfume ingredients from Trinh Table 3 in amounts required by the appealed claims and that the reference "does not enable one skilled in the art to make and use the presently claimed compositions or methods of washing tableware using such compositions" (brief, pages 12-14; reply brief, pages 4-6). In view of the teachings of Trinh that we pointed to above, we simply cannot agree with appellants' arguments, for indeed, one of ordinary skill in this art would have reasonably selected one of the base masking perfume ingredients from Trinh Table 3 because such ingredients are the majority of the non-blooming perfume ingredients listed there and Trinh specifically points to the inclusion of such ingredients at least to a "minimized"

extent.[2] On this basis, we conclude that one of ordinary skill in this art would have reasonably arrived at a suitable workable or optimum range for such ingredients following the teachings of the reference. We find that appellants essentially rely on the same arguments with respect to appealed claim 5 (brief, pages 14-15), and we find no limitation in this claim which would distinguish it from our reasons for finding appellants' arguments with respect to claim 1 unpersuasive. With respect to appellants' arguments concerning appealed claim 8 (*id.*, page 15), we note the examiner's finding that "twelve of the first twenty non-blooming perfume ingredients of [Trinh Table 3] are among the first twenty base masking ingredients recited" in the Markush group of this claim (answer, page 6).

With respect to appellants' arguments that Trinh does not disclose an amount of water falling within the ranges specified in appealed claims 18 and 20 (brief, pages 16-17; reply brief, pages 2-3), we remain convinced that one of ordinary skill would have selected an amount of water suitable for the form in which an automatic dishwashing detergent composition of Trinh is to be sold. Indeed, the preference of Trinh for a granular form for sales purposes does not detract from the teachings of the reference with respect to other forms of such detergent compositions that are commonly sold. *Merck v. Biocraft*, *supra*, quoting *Lamberti*, *supra*.

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in Trinh with appellants' countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 1 through 20 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The examiner's decision is affirmed.

[2] With respect to appellants' argument that Trinh is non-enabling with respect to the claimed invention on appeal, we note that this reference claims priority to United States Patent Application 08/618,522, which was refiled as continuation-in-part application 08/618,522, that matured into United States Patent 6,143,707, all commonly assigned with the present application.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

BRADLEY R, GARRIS Administrative Patent Judge	)	
CHARLES F. WARREN Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LINDA R. POTEATE Administrative Patent Judge	)	

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